

REMARKS

Entry of the foregoing amendment is respectfully requested. The Amendment is believed to place the application in condition for allowance and is, therefore, appropriate under Rule 116. The Amendment does not raise any new issues and, thus, does not require an additional search by the Examiner. The issues raised by the amended claim 1 is the same issued raised by the presently pending claims 1 and 5.

The Amendment was not earlier presented because applicant did not appreciate all of the Examiner's reasons for rejection until they were repeated in the final Office Action.

By the present amendment, claim 5 is canceled, and claim 1 is amended. Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

I. Objection to the Specification

The Examiner objected to the specification for describing “a collectorless” rotor and for using a reference sign “I” for allegedly identifying two different oscillation paths.

It is noted that the language “collectorless” was changed to “brushless” by the amendment filed on February 3, 2003 (please see page 3 of the amendment; a copy of page 3, together with the copy of the marked-up page 7 of the specification are enclosed).

As two double inclusion of reference sign I, it is noted that they refer to the same path. Specifically, the specification describes (please see the paragraph bridging pages 8-9) that the rotor 5 is displaceable along the axis B, together with the first subassembly, which is displaceable along the axis A, and is, therefore, displaceable by the same amount.

In view of the above, it is respectfully requested that the objection to the specification be withdrawn.

II. Rejection of Claims

The Examiner rejected Claims 1-3, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by and Claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Schmid, et al., U.S. Patent No. 4,456,076 (Schmid). The Examiner also rejected Claims 1-3, 6-10 under 35 U.S.C. § 102(b) as being anticipated by Eisenhardt, U.S. Patent No. 5,706,902 (Eisenhardt).

Claims 8-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmidt in view of Eisenhardt.

It is respectfully submitted that claims 1-10 are patentable over the cited references. Specifically, claim 1 recites that the first, oscillating subassembly, which includes the percussion mechanism, also includes a rotor of the electrical drive. This is not disclosed in the prior art. In Schmid, the rotor (9) does not form part of the oscillating subassembly (23, 24). The rotor, together with the stator and the transmission gear, form part of the second, subassembly that also includes the housing. Further, Schmid does not disclose a brushless rotor, as it is recognized in the Office Action.

The Office Action asserts that because Schmid discloses, allegedly, all the claimed features, the rejection under 35 U.S.C. § 102 is proper.

Applicant respectfully disagrees with this assertion. The Court of Appeals for the Federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation … [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” (emphasis added) Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Even we assume, *arguendo*, that Schmid includes all elements of Claim 1, in Schmid, the elements are not arranged as in the claim (claim 1). In Schmid, the rotor is not arranged for movement with the percussion mechanism relative to the second subassembly, including the housing. In Schmid, the rotor forms part of the second subassembly.

Further, applicant respectfully disagrees with the assertion that the use of the brushless rotor is a matter of design choice. In the present invention, the use of brushless rotor is necessary to provide for a free movement of the rotor,

which forms part of the first subassembly, relative to the stator which forms part of the second subassembly. Schmid does not contemplate displacing the rotor relative to the stator. Thus, there is no need in a brushless rotor in Schmid.

The Court of Appeals for Federal Circuit clearly stated that a modification of a prior art reference would not be obvious unless the prior art suggested the desirability of the modification. In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

This decision of the Court of Appeals for Federal Circuit is consistent with the decision in National Tractor Pullers Assoc., Inc. v. Watkins, 205 U.S.P.Q. 892 (D.C. NJ 1980) in which the Court held that the

test of obviousness under 35 U.S.C. 103 is not whether prior art device could be modified into something resembling applicant's structure, but whether, at time invention was made, it would have been obvious to person of ordinary skill in art, given teachings of prior art, to make the invention; in considering prior art, prior patents are references only for what they clearly disclose or suggest, and it is not proper to modify their structures in manner that is not suggested by prior art.

The Board of Patent Appeals and Interferences likewise stated that prior art must provide motivation or reason for worker in said art to make necessary

changes in reference device, without benefit of appellant's specification, in order to be obvious. Ex parte Chicago Rawhide Manufacturing Co. (PO Bd. App. 1984) 223 U.S.P.Q. 351.

The prior art does not suggest the desirability of the modification and/or motivation or reason for the modification set forth in claim 1.

In view of the above, it is respectfully submitted that Schmid does not anticipate or make obvious the present invention as defined in Claim 1, and the present invention is patentable over Schmid.

Claims 2-4 and 6-10 depend on Claim 1 and are allowable for the same reasons Claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in Claim 1 are not disclosed or suggested in the prior art.

COMMENT

At the request of the Examiner, enclosed herewith is a new drawing figure with changes approved by the Examiner, together with a letter to the Official Draftsperson.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects, in order to place in case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,

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I hereby certify that this correspondence is being deposited with the United State Postal Service as first class mail and addressed to: Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450 on May 20, 2003.

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